

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-17 are pending in the application, Claims 1-6 and 11-17 having previously been withdrawn from consideration. Claim 7 is amended by the present amendment. No new matter is presented.

In the outstanding Official Action Claim 10 was rejected under 35 U.S.C. § 101; and Claims 7-10 were rejected under 35 U.S.C. § 103(a) as anticipated by O'Neal (U.S. Patent No. 6,711,154, hereinafter "O'Neal") in view of Calvert (U.S. Patent No. 6,526,275).

Claim 10 was rejected under 35 U.S.C. § 101 because, as asserted in the outstanding Official Action, "a program-storing medium such as a carrier wave is inoperative by itself, thus it is not tangible." In response, Claim 10 is amended to recite a "program-storing medium for storing a computer-executable program, which when executed by a computer causes the computer to perform an information processing method..." Thus, the computer-executable program is executed by a hardware element, which is tangible and does not lack utility.

Accordingly, Applicant respectfully requests that the rejection of Claim 10 under 35 U.S.C. § 101, be withdrawn.

The Official Action rejected Claims 7-10 under 35 U.S.C. § 103 as unpatentable over O'Neal in view of Calvert. The Official Action cites O'Neal as disclosing the Applicant's invention with the exception of criteria including geographic information, and the information storing and transmitting commodity information based on the geographic location, as recited in independent Claims 7, 9 and 10. The Official Action cites Calvert as disclosing this claimed feature and states that it would have been obvious to one of ordinary skill in the art to combine the reference teachings to arrive at Applicants claims. Applicant

respectfully traverses this rejection as Calvert fails to teach or suggest the claimed features for which it is asserted as a secondary reference under 35 U.S.C. § 103, and there is no motivation or suggestion to combine O'Neal and Calvert.

Briefly recapitulating, amended Claim 7 relates to a method for using an interface of an information-processing apparatus to input parameters relating to a first transmission destination, a second transmission destination in a criterion for selecting either the first and second transmission destination for receiving information from an information-presenting apparatus. A transmission controller is also provided, which controls the transmission of information relating to the first and second transmission destinations and uses criterion for selecting one of the first and second transmission destinations to an information-presenting apparatus.

Further, independent Claims 7, 9 and 10 recite, *inter alia*,

...wherein said criteria includes information corresponding to a geographic location of at least one of the first and second transmission destinations and said information-presenting apparatus is configured to store and transmit commodity information corresponding to the geographic location of at least one of said first and second transmission destinations based on a determined geographic location of the at least one of said first and second transmission destinations.

As admitted in the outstanding Official Action, O'Neal fails to teach or suggest the above quoted features recited in independent Claims 7, 9 and 10.¹ In an attempt to remedy the deficiencies of O'Neal, the Official Action relies on Calvert.

Calvert describes a method and system for informing a user of a communication device where to obtain a product, based on a received geographic location of the communication device.² In addressing the above quoted features recited in the pending independent claims, the Official Action relies on col. 3, lines 18-34, col. 7, lines 53-66, col. 8,

¹Outstanding Official Action, p. 4.

²Calvert, Abstract.

lines 1-14 and col. 9, lines 13-16 of Calvert. The cited portion of Calvert describes that based on a request from the communications device, the system determines an approximate location of the communications device and whether requested products or services are available to a user within the general vicinity of the communications device. If such products or services are available, this information may be transmitted from the system to the communication device.

In contrast, independent Claim 7 recites, an interface configured to input a criterion for selecting either a first transmission destination or a second transmission destination, and a transmission controller that selects either the first transmission destination or a second transmission destination based on criteria, and that *said criteria includes information corresponding to a geographic location of at least one of the first and second transmission destinations*. Thus, independent Claim 7 clearly recites that the criteria information is used to select either a first transmission destination or a second transmission destination.

Calvert, on the other hand, describes that a request is received from a specific communication device, and the system determines the geographic location of the device in order to determine if product information is available and may be forwarded to the device. Calvert does not use the determined geographic location information to select either a first transmission or second transmission destination, as recited in the pending independent claims. Instead, as discussed above, Calvert knows where the information will be transmitted in advance because the information request is received from a specific device, thus, Calvert does not describe that a communication destination is selected based on a criterion, whatsoever.

Thus, the criteria information of Calvert is used in a manner which is fundamentally different from the features recited in independent Claims 7, 9 and 10, and Calvert fails to

teach or suggest the features of the pending independent claims for which it is asserted as a secondary reference under 35 U.S.C. § 103.

Further, Applicant respectfully traverses the obviousness rejection based on Calvert as there is insufficient evidence of motivation to modify O'Neal's method for device independent messaging notification by incorporating Calvert's geographic based product request system.

The outstanding Official Action states that the proposed modification would have been obvious "because Calvert's method of providing commodity information to the determined geographic location of the transmission destination enables O'Neal's program to obtain availability and other information for products and services of nearby locations in real-time."³ The record, however fails to provide the required evidence of motivation for a person of ordinary skill in the art to perform such a modification. While Calvert provides a reason for distributing requested product information to communication devices, Calvert fails to teach or suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in a message forwarding system such as that disclosed by O'Neal. In particular, Calvert describes receiving a request for product information from a communication device, determining the location of the device and transmitting requested geographically relevant product information to the device. Calvert, however, does not suggest that such a method would be an operable message forwarding or notification system, much less "enable" O'Neal's system to obtain availability and other information for products and services of nearby locations in real-time.

Specifically, it is unclear from the record how O'Neal's system, which forwards received messages to a selected one of user's devices, would be motivated to add the features of Calvert's system, which is directed to receiving a request from a communication device

³ The outstanding Official Action at page 6, item 13.

and forwarding advertising information to a user. O'Neal describes that its structure already achieves the goal of message forwarding and message notification based on received fax, e-mails and voicemail messages, but fails to suggest, in any way, that further improvement is desired, nor that another feature should be added to enable a user to request product information from a communication device. In particular, O'Neal's system is directed to forwarding incoming messages to user's terminals, and is not concerned with receiving a request for product information, whatsoever.

Neither Calvert nor O'Neal, therefore, provide the motivation to perform the proposed modification of O'Neal's device. In other words, an attempt to bring the isolated teachings of Calvert's system into O'Neal's system would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole. While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from somewhere within the record. In this case, the record fails to suppose the proposed modification of O'Neal's system. See In re Bergel, 130 USPQ 206, 208 (CCPA 1961)("The mere fact that it is possible to find two isolated disclosures that might be combined in such a way to produce the [invention] does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.")

Moreover, the rejection is clearly misplaced because the proposed combination would require an extensive modification to O'Neal that, if performed, would change the desired operating principal of O'Neal as to cause the system to not only determine the current geographical location of a user's device, but would also cause the system to determine whether product information is available at the device's current location. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959).

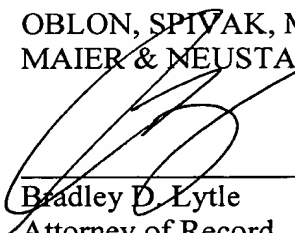
In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record, and by "clear and particular" evidence of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying O'Neal's system by incorporating Calvert's geographically based product information request system. Without such motivation and absent improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 7-10 are believed to be non-obvious and patentably over the applied references.

Accordingly, Applicant respectfully requests that the rejection of Claims 7-10 under 35 U.S.C. § 103 be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 7-10 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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